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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,937	03/12/2001	Hirofumi Uchimiya	204323US0CIP	4787

22850 7590 01/30/2004

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1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

COLLINS, CYNTHIA E

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/802,937

**Applicant(s)**

UCHIMIYA ET AL.

**Examiner**

Cynthia Collins

**Art Unit**

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-26 is/are allowed.
- 6) ☒ Claim(s) 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                      6) ☐ Other: \_\_\_\_\_

Art Unit: 1638

### **DETAILED ACTION**

The Amendment filed July 16, 2003, has been entered.

Claims 1-18 are cancelled.

Claims 19-30 are newly added.

Claims 19-30 are pending and are examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

All previous objections and rejections not set forth below have been withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether or not the claimed seed comprise the polynucleotide according to Claim 19, as Claims 27 and 30 recite only that the seed is obtained from a plant according to Claim 24 or Claim 29, which plants may or may not produce seed comprising the polynucleotide according to Claim 19. Amendment of Claims 27 and 30 to additionally indicate that the claimed seed comprise the polynucleotide according to Claim 19 would overcome the rejection.

Claim 28, and claims 29-30 dependent thereon, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

Art Unit: 1638

matter which applicant regards as the invention. It is unclear whether or not the claimed plant cell comprises the polynucleotide according to Claim 19, as Claim 28 recites only that the plant cell is obtained by transformation with the host bacterium according to Claim 21, which may or may not result in the transfer to the plant of the polynucleotide according to Claim 19.

Amendment of Claim 28 to additionally indicate that the claimed plant cell comprises the polynucleotide according to Claim 19 would overcome the rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Rodriguez (US Patent 5,888,789 issued March 30, 1999).

The claims are drawn to a seed obtained from the plant according to claim 24, a plant cell transformed with the host bacterium according to claim 21, a plant regenerated from said transformed plant cell, and a seed obtained from said regenerated plant.

Rodriguez teaches rice plant cells transformed with a vector comprising a hormone-inducible rice RAmy1A promoter operably linked to a GUS reporter gene, plants regenerated from said plants cells, and seed from said plants (columns 33-36). While the plants, cells and seed taught by Rodriguez do not comprise an isolated polynucleotide of SEQ ID NO:2, they need not comprise an isolated polynucleotide of SEQ ID NO:2 to anticipate the rejected claims. The

Art Unit: 1638

claimed seed is obtained from a plant according to Claim 24 or Claim 29, which plants may or may not produce seed comprising the polynucleotide according to Claim 19. Accordingly, any prior art seed would anticipate the claimed seed. Likewise, the claimed plant cell and plant are obtained by transformation with the host bacterium according to Claim 21, which may or may not result in the transfer to the plant of the polynucleotide according to Claim 19. Accordingly, any prior art cell or plant would anticipate the claimed cell and plant. Amendment of the rejected claims to indicate that the claimed seed, cell and plant comprise the polynucleotide according to Claim 19 would overcome the rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1638

**Remarks**

Claims 19-26 are allowed.

Claims 27-30 are rejected.

Claims 19-26 are deemed free of the prior art due to the failure of the prior art to teach or suggest an isolated polynucleotide comprising SEQ ID NO:2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC  
January 12, 2004

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180 1638

